

REMARKS

Applicants thank the Examiner for the very thorough consideration given the present application. Claims 1, 2, 4 and 6-11 remain in the application and claims 1 and 9 are independent.

The Office Action dated June 4, 2009 has been received and carefully reviewed. Each issue raised in the Office Action is addressed below. Reconsideration and allowance of the present application are respectfully requested in view of the following remarks.

Examiner Interview

Responsive to receipt of the Office Action, Applicants carefully reviewed the issues therein and noted rejections only now presented based upon amendments filed July 11, 2008. Applicants noted that the instant Office Action made new rejections under 35 U.S.C. § 112, first paragraph, based on both written description and enablement and § 112, second paragraph, for being indefinite. None of these rejections were necessitated by the amendment filed March 9, 2009, and upon which the “Final” Office Action was based. Therefore, contrary to the statement made in the Final Office Action, the new rejections were clearly not “necessitated” by the amendment of March 9, 2009, and under the provisions of MPEP § 706.07(a) the instant Office Action cannot be made a Final Office Action for that reason.

Accordingly, Applicants’ representative Paul T. Sewell contacted Examiner Richard Bemben to discuss the status of the Office Action dated June 4, 2009. Examiner Bemben graciously agreed in a telephone conversation on August 19, 2009 that the new rejections predicated upon the prior amendment presented last year precluded making of the instant Office Action a Final Office Action and agreed to consider withdrawing the Office Action. But Examiner Bemben indicated if he did so the Office Action would be replaced with an Office Action in which the new rejections would be withdrawn and changed to comments only, and the remaining rejections would be reissued as a Final Office Action. Applicants and Applicants’ representative greatly appreciate Examiner Bemben’s courtesies extended during the telephone Interview and his willingness to consider withdrawing some of the rejections. Inasmuch as Examiner Bemben indicated that he would merely repeat the other rejections, the instant

arguments are presented. They are directed to all of the arguments of record in the hopes of persuading the Examiner that all of the rejections of record are unreasonable for the reasons to follow and should be withdrawn, thus perhaps saving him needless effort. The above constitutes Applicants' statement of the summary of the Interview.

Claim Rejections – Written Description

Claims 1 and 9 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. The Office Action indicates that the amendment phrase “prior to the digital image data being read out of the storage medium for printing” presented March 6, 2009 and the amendment phrase “stored as fixed image data in a storage medium” presented in the amendment filed July 11, 2009 contain subject matter which was not described in the specification in such a way as to reasonably convey that the Applicants had possession of the claimed invention at the time the application was filed. The rejection is respectfully traversed.

The Examiner points to instances where it appears the specification “uses the past tense to describe when an image with associated print-specifying information is displayed”, referring to “printed state” and “frames that are printed”. Applicants submit that when the entire application disclosure is carefully considered *in toto*, it should be clear that Applicants were in possession of the claimed invention, and that the allegedly confusing phrases do not support a rejection under 35 U.S.C. § 112, first paragraph.

It appears that this rejection may be predicated upon the failure of the specification to include the exact language “prior to the digital image date being read out of the storage medium for printing” and “stored as fixed image data in a storage medium”. Among other places, MPEP § 2163 describes the written description requirement, which is in its essence the requirement that applicant be in possession of what is claimed at the point of the filing of the application. It is submitted that there is clear support for the above noted claimed features for the following reasons. First, MPEP § 2163 makes clear that “there is no *haec verba* requirement”, only that “newly added claim limitations be supported in the specification through express, implicit or inherent disclosure.” Here the phrase “prior to the digital image date being read out of the

storage medium for printing” merely carries the meaning defined by the words – that the display is used to indicate which images are to be printed, that is “to be used during printing” in the words of original claim 9 and “total number of print sheets to be used in printing” in the words of original claim 12. Thus, the specification text at page 10, line 22 though page 11, line 5 and page 11, lines 17-21, when read in light of the remainder of the specification, support displaying the print-specifying information “to be used during printing” in the words of original claims 9 and 12.

The specification as filed also makes clear on pages 10 and 11 that increment and decrement buttons 5 and 6 are used for “changing the number or order sheets”, which is consistent with the use of these buttons to create order information “to be used during printing”, again in the words of original claim 9. With respect to the claim phrase “stored as fixed image data in a storage medium”, page 10, lines 12-20, clearly indicate that the digital camera “stores image data acquired by photographing in a memory card” and that in the erasing mode the digital camera “erases unnecessary image data recorded on the memory card provided in the main camera body 1, or performs formatting of the memory card.” By describing a memory card that formats, stores and erases digital data, Applicants respectfully submit that “one skilled in the art” would reasonably have concluded that such a memory works in this manner. Therefore, it is submitted that the instant specification provides support for the claim phrases at issue.

MPEP § 2163 states further that “The claims as filed in the original specification are part of the disclosure and, therefore, if an application as originally filed contains a claim disclosing material not found in the remainder of the specification, the applicant may amend the specification to include the claimed subject matter. *In re Benno*, 768 F.2d 1340, 226 USPQ 683 (Fed. Cir. 1985).” Should the Examiner require it, Applicant would have no objection to adding the phrase or phrases identified by the Examiner to the specification.

Claim Rejections – Enablement

Claim 1 stands rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. This rejection is also respectfully traversed.

MPEP § 2164.01(a) discusses in detail the eight *Wands* factors that must be analyzed in detail on the record in order to establish whether any necessary experimentation is “undue”. MPEP § 2164.01(a) specifically indicates “It is improper to conclude that a disclosure is not enabling based on an analysis of only one of the above factors while ignoring one or more of the others. The examiner’s analysis must consider all the evidence related to each of these factors, and any conclusion of nonenablement must be based on the evidence as a whole. 858 F.2d at 737, 740, 8 USPQ2d at 1404, 1407.”

The instant Office Action has presented no analysis of the *Wands* factors necessary to establish evidence of lack of enablement. Accordingly, inasmuch as the Office Action has failed to present any of the analysis necessary, *prima facie* lack of enablement has not been established and the rejection should be withdrawn. Applicants respectfully submit that the instant specification when filed contained sufficient information regarding the subject matter of the claims for one skilled in the pertinent art to make and use the invention.

Should the Examiner persist in making this rejection, he is respectfully requested to present an analysis of the *Wands* factors, at least including those listed in MPEP § 2164.01(a), as would be necessary to support a conclusion of lack of enablement.

Claim Rejections – 35 U.S.C. § 112, Second Paragraph

Claim 1 also stands rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. This rejection is also respectfully traversed. The rejection merely indicates “Refer to the reasoning above.” MPEP § 2173.01 establishes the standard for indefiniteness is a “*reasonable* degree of particularity and distinctness” and allows “some latitude” in the manner of expression. In addition, in making a rejection for indefiniteness this section of the MPEP directs Examiners to explain why specific phrase(s) might be unclear, and if possible provide suggested claim language to improve the clarity. Inasmuch as the Examiner has not identified the specific language at issue, it is not clear as to what claim language in particular the Examiner might be referencing. Should the rejection be maintained, the Examiner is respectfully requested to identify what language the Examiner believes to be indefinite so that Applicants may properly respond. Based upon a careful review of the specification and claims, it is respectfully submitted

that the instant claims clearly define the boundaries of the subject matter for which protection is sought and therefore particularly point out and distinctly claim the subject matter which the Applicants regard as their invention. Reconsideration and withdrawal of the rejection are respectfully requested.

Claim Rejections - 35 U.S.C. § 102

Claims 1 and 9 stand rejected under 35 U.S.C. § 102(e) as anticipated by Kawamura. Applicants submit that the Examiner has failed to establish a *prima facie* case of anticipation and respectfully traverse the rejection. A complete discussion of the Examiner's rejection is set forth in the Office Action, and is not being repeated here.

In order to establish a *prima facie* case of anticipation under 35 U.S.C. § 102, the cited reference must teach or inherently include each and every element of the claims. See MPEP § 2131; MPEP § 706.02.

The Office Action takes the position on page 6 that column 9, lines 50-60, of Kawamura anticipates the requirement that the digital image data having print-specifying information and not having print-specifying information are displayed on the display prior to the digital image data being read out of the storage medium for printing. It appears that the Examiner is interpreting the reference feature in which Kawamura displays a number of transfer icons that corresponds to the number of times the transfer has occurred before all of the transfers have occurred, as meeting the claim. Applicants respectfully submit that these claims do not read on the process or structure described in the reference. Kawamura merely shows that the same number of icons (51 and 52) as the number of completed transmissions are displayed. The change in display only occurs after, and as a result of, the data transmission. Note in particular Figure 4, which shows the transfer mode flow, which indicates at steps S9 and S11, and again at steps S14 and S16, that the icon is not applied until after the transfer has finished. Thus the icons are not used as displaying a number which indicates how many copies of a photograph a user wishes to print or are to be printed. And, thus the icons are not applied before any of the digital image data is read out of the camera storage medium for printing. Reconsideration and allowance are respectfully requested.

Claim Rejections – 35 U.S.C. §103(a)

Claims 2, 6, 7, 10 and 11 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Kawamura in view of Honda. Applicants submit the Examiner has failed to establish a *prima facie* case of obviousness and respectfully traverses the rejection. A complete discussion of the Examiner's rejection is set forth in the Office Action, and is not being repeated here.

In order to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a), the cited references must teach or suggest each and every element in the claims. See MPEP § 706.02(j); MPEP §§ 2141-2144.

Honda has been cited to show printing-specifying information, such as a number of print sheets, displayed with the recorded image on the camera display as appears in Figures 30A, 30C, 31, 32A and 32B. To the contrary, we note that Honda only discloses presenting a full frame image with all of the printing-specifying information for every image. Honda never discloses or suggests displaying digital image data of a number of thumbnail images at the same time in the camera display. Honda never discloses or suggests displaying images for which printing-specifying information was set and digital image data with no printing-specifying information so they may be discriminated from each other when they are displayed on said displaying means prior to the digital image data being read out of the storage medium for printing, and therefore Honda cannot remedy the defects of Kawamura discussed above. The secondary reference to Honda neither discloses nor suggests simultaneous display of both kinds of images prior to the image data being read out of the storage medium, as recited in amended claims 1 and 9, from which claims 2, 6, 7, 10 and 11 depend. Accordingly, the Office Action fails to make out a *prima facie* case of obviousness of the subject matter recited in currently pending claims 2, 6, 7, 10 and 11.

Claim Rejections - 35 U.S.C. §103, including Hanzawa

Claims 4/1 and 8 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Kawamura in view of U.S. Pat. No. 5,506,661 to Hanzawa. Claim 4/2 stands rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Kawamura in view of Honda and Hanzawa.

Hanzawa was cited for showing a display of only the printing-specifying data on the display and for displaying a printing price value on the display. To the contrary, we note that Hanzawa is not directed to the display on a digital camera as claimed, but to the display on a mimeographic production printing apparatus as shown in Figure 1 and as described in column 3, lines 15-22 and column 4, lines 33-39. Hanzawa merely calculates and displays the price for a mimeograph order using the apparatus in Figure 3 and the flow chart of Figure 4. Hanzawa provides no teachings or suggestions related to images stored in a digital camera. Hanzawa does not supply the missing features of claim 1 that are lacking from Kawamura. Moreover, it is not clear how one might combine the disclosures of Kawamura and Hanzawa since Hanzawa is not directed to a digital camera at all, but is instead directed to the display for mimeographic apparatus. Such an apparatus cannot display a digital photograph at all and can only display print control parameters. The rejection is silent as to what would create a nexus that would connect such disparate prior arts. Claims 4 and 8 are additionally submitted to be allowable for the reasons set forth above regarding claim 1 for the further features claimed therein.

Conclusion

All objections and rejections raised in the Office Action having been properly traversed and addressed, it is respectfully submitted that the present application is in condition for allowance. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance. Notice of same is earnestly solicited.

Prompt and favorable consideration of this Amendment is respectfully requested.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone Paul T. Sewell, Registration No. 61,784, at (703) 205-8000, in the Washington, D.C. area.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.14; particularly, extension of time fees.

Dated: August 25, 2009

Respectfully submitted,

By _____

D. Richard Anderson
Registration No.: 40,439
BIRCH, STEWART, KOLASCH & BIRCH, LLP
8110 Gatehouse Road
Suite 100 East
P.O. Box 747
Falls Church, Virginia 22040-0747
(703) 205-8000
Attorney for Applicant